REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Final Official Action, the Examiner rejected claims 7-10, 14-16, 21-23, 25, 26 and 35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,069,273 to O'Hearne et al., (hereinafter "O'Hearne"). Furthermore, the Examiner rejected claims 11-13 under 35 U.S.C. § 103(a) as being unpatentable over O'Hearne. Additionally, the Examiner rejected claims 17 and 24 under 35 U.S.C. § 103(a) as being unpatentable over O'Hearne in view of U.S. Patent No. 6,619,768 to Northrop et al., (hereinafter "Northrop"). Lastly, the Examiner rejected claims 18-20 under 35 U.S.C. § 103(a) as being unpatentable over O'Hearne in view of U.S. Patent No. 6,619,768 to Northrop et al., (hereinafter "Northrop") in view of U.S. Patent No. 3,914,957 to Jacobs (hereinafter "Jacobs").

In response, independent claims 21 and 35 have been amended to clarify their distinguishing features.

In the Final Official Action, the Examiner argued that the distinguishing features argued in the previous response are (1) directed to an intended use and (2) the device of O'Hearne is capable of performing the intended use.

With regard to (1), the preambles of claims 21 and 35 have been amended to add that the steam sterilization storing device is "for sterilized medical equipment." The body of claim 21 has been amended to be consistent with the amended preamble thereof. Thus, since such features recited in the body of claims 21 and 31 now refer back to the preamble, the preamble must now be given patentable weight.

With regard to (2), claims 21 and 35 have been further amended to include a specific feature of the cooling holding unit, Specifically, claims 21 and 35 have been amended

to recite that --the cooling holding unit having one or more fans positioned to direct an airflow over a predetermined portion of the sterilized equipment.-- Thus, Applicants respectfully submit that the device of O'Hearne does not disclose such features and is also not capable of performing the intended use thereof.

With regard to the rejection of claims 7-10, 14-16, 21-23, 25, 26 and 35 under 35 U.S.C. § 102(b), a steam sterilization storing device for sterilized medical equipment having the features discussed above and as recited in independent claims 21 and 35, are nowhere disclosed in O'Hearne. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"[1] independent claims 21 and 35 are not anticipated by O'Hearne. Accordingly, independent claims 21 and 35 patentably distinguish over O'Hearne and are allowable. Claims 7-10, 14-16, 21-23, 25 and 26 being dependent upon claim 21, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 7-10, 14-16, 21-23, 25, 26 and 35 under 35 U.S.C. § 102(b).

With regard to the rejections of claims 11-13, 17-20 and 24 under 35 U.S.C. § 103(a), since independent claim 21 patentably distinguishes over the prior art and is allowable, claims 11-13, 17-20 and 24 are at least allowable therewith because they depend from allowable base claim 21. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 11-13, 17-20 and 24 under 35 U.S.C. § 103(a).

Lastly, with regard to the rejections of claims 11-13, 17-20 and 24 under 35 U.S.C. 103(a), Applicants respectfully submit that O'Hearne is non-analogous art since it is from a different technical field and directed to a different objective. Applicants further submit

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[1] Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

that the amendment to the preamble, as discussed above, makes the fact that O'Hearne is non-analogous art even more apparent, since the claims are now clearly directed to steam sterilization storing devices for sterilized medical equipment.

Applicants respectfully submit that at least the O'Hearne reference is not proper because it is from a non-analogous art. To be considered analogous art, the reference cited by the Examiner must be either in the same field as the invention or be reasonably pertinent to the problem faced by the inventor.[2] Applicants respectfully submit that neither of these requirements have been met in the present case.

With regard to the first prong of the non-analogous art test, namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

> We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" -in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.[3]

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the field of the reference for a solution to the problem facing the inventor.[4]

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[2] See, e.g., In re Clay, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and Wang Labs., Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

[3] In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

[4] Id. See also, In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) ("[A]s with all section 103 decisions, judgement must be brought to bear based on the facts of each case.").

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

> [a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.[5]

With regard to the first prong of the non-analogous art test, and in view of the Federal Circuit's narrow view of what is in the same field of endeavor,[6] it cannot be said that the O'Hearne reference (directed to a food server) is within the same field of endeavor as the present invention, which is directed to a steam sterilization storing device for medical equipment. Thus, Applicants respectfully submit that O'Hearne is not in the same field of endeavor as the present invention, as recited in claims 21 and 35.

With regard to the second prong of the non-analogous test, Applicants respectfully submit that O'Hearne is not reasonably pertinent to the particular problem with which the inventor of the present invention was involved.

As discussed in the specification, the present invention is directed to the problem of providing a storage unit capable of cooling, drying, and storing medical equipment to be sterilized by steam under high temperature and high pressure, such as endoscopes. This

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[5] *In re Clay*, 23 USPQ 2d at 1060-1061.

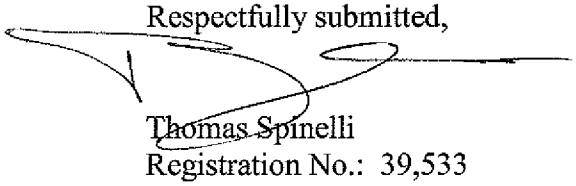
[6] In *Wang Laboratories*, 26 USPQ 2d 1767, in which the present invention related to memory circuits and the cited reference referred to compact modular memories, the Federal Circuit held that the cited references were not in the same field of endeavor, stating that the reference "... is not in the same field of endeavor as the claimed subject matter merely because it relates to memories."

is a very different problem then faced by the inventor of O'Hearne. In O'Hearne, the inventor was concerned with serving food to large numbers of people, such as in a hospital with many patients. Thus, O'Hearne was not faced with the same problem as was the inventor of the present invention. To paraphrase the words of the Federal Circuit, the matter with which O'Hearne deals logically would not have commended itself to the inventor's attention in considering his problem. Thus, since O'Hearne is directed to different purposes, the inventor would accordingly have had no motivation or occasion to consider O'Hearne.

Accordingly, the Applicants respectfully submit that at least O'Hearne is not in the same field of endeavor as the present invention, as recited in claims 21 and 35, nor is it reasonably pertinent to the particular problem with which the inventor of the present invention was involved. Consequently, the Examiner is respectfully requested to withdraw at least the O'Hearne reference, thereby rendering the 35 U.S.C. 103(a) rejections of claims 11-13, 17-20 and 24 moot.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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